

Remarks

This is responsive to the Office Action mailed November 15, 2010. Applicant respectfully traverses the standing rejections and requests reconsideration for the reasons set forth below. Absent that reconsideration, Applicant also shows below that the Office's rationale for the rejections leaves unresolved factual issues that must be addressed before it can be said that this case is in condition for appeal (again).

Rejection Under Section 112(1)

The Office rejected claims 1, 3, 5-9, and 21-24 for allegedly failing to comply with the written description requirement. Particularly, the Office believes the claim 1 feature of disposing the discs symmetrically around the motor hub feature is new matter:

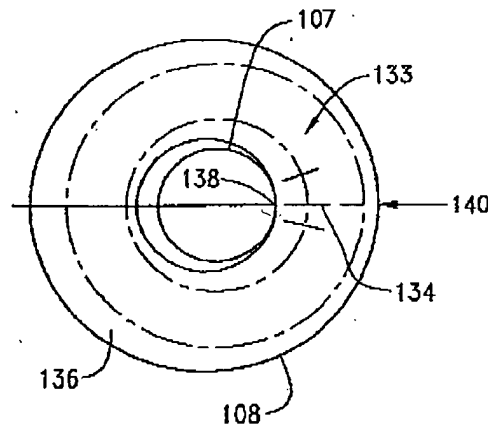
In Claim 1, the recitation of "the prewritten discs placed around the motor hub with respect to each other so that the alignment axes amount [sic: among] the plurality of prewritten discs are angularly disposed symmetrically around the motor hub" (lines 6-9) is new matter. The specification and drawings, as originally filed, provide no written description of any alignment axes of the prewritten discs being angularly disposed symmetrically around the motor hub. The specification, as originally filed, does not even use the terms of "angularly disposed" or "symmetrically."

alignment axis

The Office continues in its error of ignoring the plain meaning of *alignment axes*. Contrary to the Office's reticent insistence on continuing to parse the claim language to change its meaning, claim 1 plainly features *a plurality of prewritten discs, each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis*.... Applicant reiterates that it is reversible error for the Office to attempt to ascribe

some meaning to “alignment axis” that ignores the contextual meaning “concentricity offset,” because the *alignment axis* plainly defines the direction of the *concentricity offset*.

Applicant has also shown that FIG. 2 and the descriptions thereof clearly disclose a prewritten disc 108 having a servo track pattern (depicted by broken circles¹) that is characterized by a concentricity offset in a direction of alignment mark 134.



Applicant has shown that the skilled artisan having read the specification understands that only in some embodiments is it necessary to produce the alignment mark as a physically existent indicia on the disc.² That is, the specification explicitly discloses it to be advantageous to produce the concentricity offset in mere relation to an alignment axis, without any need to physically produce indicia on the disc:

In yet another preferred embodiment, no alignment mark is placed on the prewritten disc at all. After the servo information has been written to the disc, the position of the disc is precisely monitored relative to the biasing forces used during servo write and placed in a carrier for storage.³

¹ See specification pg. 6:29-30.

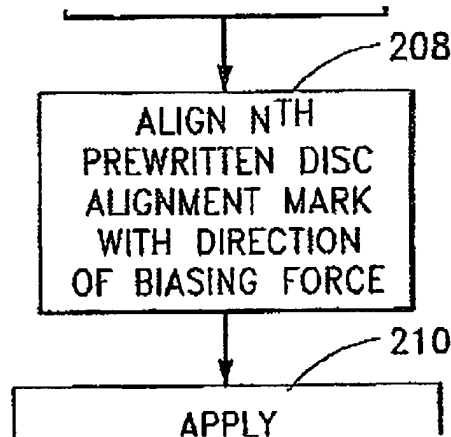
² See specification pg. 8:4-5.

³ See specification pg. 8:12-15 (emphasis added).

The skilled artisan having read the specification understands that the alignment axis in all embodiments is defined by the radial axis along which the biasing force was applied to the disc during servo write. Thus, the alignment axis exists in all embodiments, whether the alignment mark in terms of a physical indicia is used or not. The skilled artisan thus understands that the alignment mark 134, whether physically existent or not, defines the featured *alignment axis*. The skilled artisan knows with certainty what the scope of the term *alignment axis* is from this information which is found in the originally filed specification.

alignment axes symmetrically disposed around the motor hub

FIG. 2 above depicts the prewritten disc 108 being biased against the motor hub 107 by a biasing force 140. The prewritten disc has been positionally rotated to radially align the alignment mark 134 with the direction of the biasing force 140. This process is described in the alignment step in block 208 of the method depicted in FIG. 3:



The direction of the biasing force (such as biasing force 140) is disclosed as being that which advantageously balances the plurality of discs that form a disc stack:

In an embodiment of a disc stack assembly having multiple prewritten discs 108, it is desirable to balance the disc stack assembly for rotation about the spindle motor hub 107. For disc stack assemblies with even numbers of discs, this may be

accomplished by applying the biasing force for a particular disc in an opposite direction from any disc above and below that particular disc. For disc stack assemblies with odd numbers of discs, the biasing force should be applied to each disc at even angular intervals about a circumference of the discs 108. For example, if there are three discs, the biasing force for any particular disc should be applied to the outer diameter of the particular disc 108 one-hundred-twenty degrees apart from the direction of each of the biasing forces applied to the remaining two discs 108.⁴

The skilled artisan having read the specification readily understands that placing the alignment axes “symmetrically around the motor hub,” as featured in claim 1, is a meaning that plainly includes placing them oppositely (180 degrees apart) in a stack of even number of discs, and includes placing them at even angular intervals (such as 120 degrees apart for three discs) in a stack of an odd number of discs. Therefore, the skilled artisan finds clear support for the *alignment axes...are angularly disposed symmetrically around the motor hub* feature of claim 1, and that support is from information which is found in the originally filed specification.

Summarizing, Applicant reiterates that the legal criteria for satisfying the written description requirement is whether Applicant has disclosed the technologic knowledge upon which the rejected claim is based, and demonstrated a possession of the claimed invention at the time of filing.⁵ The written description requirement does not require the applicant to describe the claimed invention in exactly the same terms chosen for the claim language; rather, the description must clearly allow persons of ordinary skill in the art to recognize that he invented what is claimed.⁶ Contrary to the Office’s stated position, there simply is no written description requirement that the criteria can only be satisfied in terms of the explicitly

⁴ Specification pg. 8:20-30 (emphases added).

⁵ *Ariad Pharmaceuticals v. Eli Lilly and Co.*, 2008-1248 (Fed. Cir. 2010) *en banc*.

⁶ *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989 (Fed. Cir. 2000), *cert. denied*.

recited terms in the claim, such that only some explicit usage of the terms “angularly disposed” and “symmetrically” could allegedly provide the requisite written description support.⁷

Rather, Applicant has shown that the Office’s perceived written description deficiency is actually due to it ignoring the ordinary meaning of the rejected claim, in terms of the broadest reasonable interpretation of *alignment axis*, and ignoring explicit disclosure in the specification in support of that broadest reasonable interpretation.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom. Absent that reconsideration, both the Office’s claim interpretation and understanding of the disclosure in the specification leave unresolved factual issues that are not bona fide matters for appeal, but which must rather be addressed before it can be said that this case is in condition for appeal.

Rejection Under Section 112(2)

Claims 1, 3, 5-9, and 21-24 stand rejected for allegedly reciting indefinite language. The issue here is the same as that described above, in that the Office’s rationale is that the language *alignment axis* is indefinite:

A person of ordinary skill in the art would not understand what alignment axis is being referred to. For example, angular directions for the discs can occur into and out of the page (of Figure 2). Therefore, it would be impossible to determine an alignment axis that would be the very same angular direction for all of the discs in a plane into and out of the page (of Figure 2). Accordingly, the claims terms are not sufficiently described in the

⁷ Office Action pg. 3: “The specification, as originally filed, does not even use the terms of “angularly disposed” or “symmetrically.”

specification and the meaning of the claims is undeterminable, subject to plural interpretations, and therefore indefinite.⁸

For the same reasons set forth above in rebuttal of the written description rejection, the Office's rationale is reversible error because it attempts to interpret *alignment axis* by parsing it from the context of the claim language of which the disputed term only forms a part. Particularly, Applicant has shown that the disputed term's meaning cannot be ascertained by divorcing it from the plain meaning that the servo tracks are featured as being concentrically offset in the direction of the alignment axis. Applicant has also shown that the skilled artisan having read the specification readily understands that support for the featured *alignment axis* is found in the alignment mark 134. Applicant's decision not to support the claim language with explicit usage of the claim term in the specification does not in-and-of-itself render a claim indefinite. Rather, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.⁹

The Office's only evidence that it would be impossible for the skilled artisan to render an understanding of *alignment axis* is that it could allegedly include an indeterminable number of axes into and out of the sheet of paper on which FIG. 2 is depicted. Applicant has repeatedly traversed that rationale as being reversible error. Again, properly construing the disputed term in the context of the claim language as a whole, the *alignment axis* is the direction in which the servo tracks are concentrically offset. Applicant has shown that the skilled artisan readily knows that it would unreasonable (even nonsensical) to argue that the servo tracks could be concentrically offset in any plane other than the plane of the disc 108. Contrary to the Office's rationale, the skilled artisan knows that the servo tracks cannot be

⁸ Office Action pg. 4.

⁹ *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992); MPEP 2173.05(e).

concentrically offset in any direction into or out of the sheet of paper on which FIG. 2 is depicted.

It is also respectfully pointed out that where Applicant traverses any rationale, the Office should, if repeating the rationale, take note of Applicant's argument and answer the substance of it.¹⁰ By answering the substance of Applicant's argument, the Office provides a complete application file history which enhances the clarity of the prosecution history record. However, in this case the Office has not answered the substance of Applicant's arguments with respect to the fact that the *alignment axis* cannot lie in any plane other than the disc plane. Accordingly, if the Office continues to apply its rationale otherwise, Applicant respectfully requests that the Office address Applicant's arguments in order to provide a complete application file history and to enhance the clarity of the prosecution record.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom. Absent that reconsideration, again, both the Office's claim interpretation and understanding of the disclosure in the specification leave unresolved factual issues that are not bona fide matters for appeal, but which must rather be addressed before it can be said that this case is in condition for appeal.

Rejection Under Section 102

Claims 1, 3, 5-7, and 9 stand rejected as allegedly being anticipated by Kuroba (US 6,081,990). Applicant respectfully traverses the rejection.

The Office's rationale is that Kuroba allegedly identically discloses the featured *placing step* of claim 1:

¹⁰ MPEP 707.07(f).

Kuroba discloses a method comprising: placing a plurality of prewritten discs 20, each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis that is the same angular direction for all of the plurality of the prewritten discs in relation to a center of the respective prewritten disc, around a motor hub (spindle 21)....¹¹

Applicant has already shown in the record that Kuroba does not identically disclose at least *placing a plurality of prewritten discs, each disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs*....¹²

Applicant reiterates that claim 1 features prewritten discs having servo tracks concentrically offset in the same angular orientation, and those prewritten discs are subsequently placed so that the alignment axes are disposed symmetrically around the motor hub in alignment with the desired biasing directions.

For example, without limitation, in a three-disc stack all of the discs have servo tracks written to them concentrically offset in the same direction, such as in the zero degree direction of the alignment mark depicted in FIG. 2 and discussed in the Reply Brief. That advantageously permits writing the servo tracks to all three discs in one setup, and even writing the servo tracks to all three discs simultaneously. After the discs are prewritten, they are then placed around the motor hub so that the alignment axes are disposed symmetrically. In this example, the alignment axes would be 120 degrees apart. Therefore, claim 1 features a plurality of discs having servo tracks that are written concentrically offset in relation to an alignment axis that is in the same direction for all of the discs, but yet each disc has a

¹¹ Office Action pg. 4.

¹² Reply Brief ppg. 7-8.

different contact position against the motor hub in aligning the prewritten disc with the desired biasing force.

Applicant has repeatedly shown that Kuroba discloses a different solution whereby each of the three discs in this example would necessarily be written individually with respect to its contact position against the motor hub:

If a plurality of disk media 20 are stacked, a balance control can be attained by the following manner. The position at which the inner periphery of the disk medium comes into contact with the outer periphery of the spindle hub is changed alternately one by one at positions symmetrically with respect to the axis E of rotation. Otherwise, the contact position is changed by a certain angle, one after another, for the respective disks. However, in a case of the data surface servo system, the servo track writing (STW) must be performed individually for the groups of disks in which the contact position is changed for the respective groups.¹³

Applicant has also repeatedly pointed out that the skilled artisan readily recognizes that the only reason that the discs in Kuroba must be written in groups according to their respective contact positions against the motor hub is that the servo pattern offsets are written in relation to alignment axes that are in different directions. If they were written in relation to alignment axes in the same direction, as in the claimed embodiments, then there would be no necessity to write them individually as Kuroba mandates.

The Office has not shown that Kuroba identically discloses at least the *each disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs* feature of claim 1.

Moreover, this "newly raised" issue has already been to appeal and back. It is respectfully pointed out that where Applicant traverses any rationale, the Office should, if

repeating the rationale, take note of Applicant's argument and answer the substance of it.¹⁴ By answering the substance of Applicant's argument, the Office provides a complete application file history which enhances the clarity of the prosecution history record. However, in this case the Office has not answered the substance of Applicant's arguments with respect to the fact that Kuroba explicitly discloses the opposite of what the Office asserts that it discloses. Accordingly, if the Office continues to apply its rationale otherwise, Applicant respectfully requests that the Office address Applicant's arguments in order to provide a complete application file history and to enhance the clarity of the prosecution record.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom. Absent that reconsideration, the Office's misplaced characterization of what Kuroba discloses leaves an unresolved factual issue that is not a bona fide matter for appeal, but which must rather be addressed before it can be said that this case is in condition for appeal.

Section 103 Rejection

Claim 8 stands rejected over Kuroba in view of JP 5-205442. However, the JP reference does not cure the deficiency of Kuroba in the rejection of claim 1. Claim 8 is therefore allowable at least because it depends from an allowable independent claim, for reasons above, and recites an additional feature. Applicant respectfully requests reconsideration and withdrawal of the rejection.

¹³ Kuroba col. 8:38-41 (emphasis added).

Conclusion

This is a complete response to the pending action in this case. Applicant respectfully requests passage of all claims to allowance.

Applicant has also submitted herewith a request for telephone interview if, after having reviewed this Response, the Office determines that any of the claims are not in condition for allowance. The presently requested interview is necessary and appropriate to best facilitate progress on the merits by addressing the unresolved factual issues presently making this case not in condition for appeal.

The Office is encouraged to contact the undersigned should any question arise concerning this response or anything else concerning this case.

Respectfully submitted,

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¹⁴ MPEP 707.07(f).